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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/627,791

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EXAMINER

PREBILIC, PAUL B

ART UNIT

PAPER NUMBER

3774

MAIL DATE

DELIVERY MODE

06/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/627,791	Applicant(s) BIGUS ET AL.	
	Examiner Paul B. Prebilic	Art Unit 3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-11 and 20-39 is/are pending in the application.
- 4a) Of the above claim(s) 8-10,22,23 and 31-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-7,11,20,21,24-30 and 35-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Claims 8-10, 22, 23, and 31-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 19, 2006.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 25-30 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Kocur (US 6,350,277). Kocur anticipates the claim language where the catheter as claimed is the catheter of Kocur (see column 9, lines 44-53), the self-expandable endoprosthesis as claimed is the self-expanding stent (110) of Kocur (see column 4, lines 3-13), and the bioabsorbable material as claimed is the retaining segment of Kocur (see column 2, lines 1-9). As can be clearly seen in Figures 1, 2, 3, 4a, 4b, 7, 8, 11a, 11d, and 13a, the extreme ends of the stent do not have bioabsorbable material (i.e. the retention structure) overlying them so the retention structure does not overlie the distal or proximal end as claimed.

Claims 1, 5-7, 11, 20, 21, 24, 35, and 37-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Kocur (US 6,350,277) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kocur (US 6,350,277) in view of Lenker et al (US 6,126,685) or Bachinski et al (US 6,036,702).

Kocur anticipates the claim language where the catheter as claimed is the catheter of Kocur (see column 9, lines 44-53), the self-expandable endoprosthesis as claimed is the self-expanding stent (110) of Kocur (see column 4, lines 3-13), and the bioabsorbable material as claimed is the retaining segment of Kocur (see column 2, lines 1-9). The definition of "score" and "perforation" are considered synonymous such that the punched holes (223) of the Figure 5c embodiment of Kocur are considered to constitute "scoring" as claimed; see the definitions of "score" and "perforation" (second definitions of each that are so similar that they are considered synonymous).

Alternatively, one may not consider the punched holes (223) of Kocur to constitute scoring as claimed. However, Lenker (see Figure 24A to 24C and column 12, lines 18-31) or Bachinski (see Figure 26b and column 13, lines 22-28) teaches that it was known to substitute scoring as an alternative to perforations. Therefore, it is the Examiner's position that it would have been obvious to utilize scoring in the Kocur invention as a simple substitution of one feature for an equivalent feature within the art; see MPEP 2143 that is incorporated herein by reference.

With regard to claim 5, the Applicant is directed to Figures 7 and 8 and column 4, line 58 to column 5, line 7. Heat bonding is also taught by Kocur; see Figures 5a to 5c,

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10, 11d, and 13a to 13d as well as column 4, line 18 et seq., column 6, line 5 et seq., and column 5, line 18 et seq.

Regarding claim 6, the Applicant is directed to see Figures 1, 3, 4a, and 4b.

Regarding claim 7, the bands of Figure 5a and 5b can be near or at the ends of the stent such that the greatest (and the least) thickness would be at the ends as claimed.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are unpersuasive. The Strecker rejection has been withdrawn to the arguments pertaining thereto are considered moot.

With respect to the traversal of claims 25 to 30 and 36 that there is no explicit or implied teaching of leaving the ends of the stent uncovered, the Examiner respectfully disagrees. In particular, Figures 1-3, 4a, 4b, 7, 8, 11a, 11d, and 13a clearly show that the extreme ends of the stent are not covered by the retention structure. For this reason, the claim language is fully met to the extent required.

In response to the traversal of the Kocur rejection of claim 1, 5-7, 20, 21, 24, 35, and 37-39 that scoring or thinner diameter portions are not taught, the Examiner respectfully disagrees. Since the punched holes (223) of Figure 5c constitute an structure equivalent to a scored surface, the claim language is considered fully met in this regard; see the definitions of "score" and "perforation" (second definitions of each that are so similar that they are considered synonymous.

Alternatively, one may not consider the punched holes (223) of Kocur to constitute "scoring" as claimed. However, Lenker (see Figure 24A to 24C and column 12, lines 18-31) or Bachinski (see Figure 26b and column 13, lines 22-28) teaches that it was known to substitute scoring as an alternative to perforations. Therefore, it is the Examiner's position that it would have been obvious to utilize scoring in the Kocur invention as a simple substitution of one feature for an equivalent feature within the art; see MPEP 2143 that is incorporated herein by reference.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be

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applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/
Paul Prebilic
Primary Examiner
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